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<p>Zak Muscovitch</p> <p>"How one guy games new gTLD sunrise periods", DomainIncite, April 17, 2014</p> <p>http://domainincite.com/16492-how-on-e-guy-games-new-gtld-sunrise-periods</p> <p>==</p> <p>This article shows the example of someone registering trademarks specifically in order to get priority for Sunrise registrations. It also shows how the low threshold for use was met. The registrant registered three Swiss trademarks at relatively low cost in connection with pens so as to easily be able to demonstrate use. The marks were for common terms, namely DIRECT, SOCIAL, and CLOUD.</p>	<p>See Sunrise Questions Table, Q1(d) through (f).</p> <p>==</p> <p>This article documents instances of how the current system may be used in a manner which was not intended and which may in the view of some registrants, trademark owners, and registries, constitute an abuse of the current system which requires consideration of potential revisions. One must wonder whether it is fair for the current system to enable a sophisticated participant to get first dibs on such common terms through this method, and whether this outcome was what was intended.</p>	<p>George Kirikos: I think Zak is referencing charter Preamble questions (d) through (f), and I agree with that analysis. It also might help inform our work on charter Q1(a) [expanding matches when so many dictionary terms have been gamed would allow even more gaming], Q5(b) [potential elimination of mandatory sunrise], Q9 (limiting to the class of goods/services might reduce gaming), and Q10 ("token use" not properly addressed by TMCH validation system). In addition to the article itself, the comments below the article (particularly by John Berryhill) further illustrate the issues.</p>
<p>Zak Muscovitch</p> <p>"Fake Trademarks Stealing Generic Domains In New gTLD Sunrises", OnlineDomain.com, April 15, 2014</p>	<p>See Sunrise Questions Table, Q1(d) through (f).</p> <p>==</p>	<p>George Kirikos: again, I think Zak is referencing charter Preamble questions (d) through (f), and I agree with that analysis. It also might help inform our work on charter Q1(a) [expanding matches when so many</p>

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<p>https://onlinedomain.com/2014/04/15/egal/fake-trademarks-stealing-generic-domains-in-new-gtld-sunrises/</p> <p>==</p> <p>This article tells how a sophisticated party used the current Sunrise system to acquire 300 premium generic domain names before anyone else. The registrant registered domain names such as cloud.guru, social.photos, Build.house, BET.guru, online.bike, VACATION.photos, discount.repair etc., using genuine trademarks for goods such as pens, guitar picks, etc., solely in order to get priority registration. The article calls this a "Sunrise scavenger scam" and claims that the only purpose of acquiring the corresponding trademark rights was to game the current system.</p>	<p>This article documents instances of how the current system may be used in a manner which was not intended and which may in the view of some registrants, trademark owners, and registries, constitute an abuse of the current system which requires consideration of potential revisions. One must wonder whether it is fair for the current system to enable a sophisticated participant to get first dibs on such common terms through this method, and whether this outcome was what was intended.</p>	<p>dictionary terms have been gamed would allow even more gaming], Q5(b) [potential elimination of mandatory sunrise], Q9 (limiting to the class of goods/services might reduce gaming), and Q10 ("token use" not properly addressed by TMCH validation system). In addition to the article itself, the comments below the article further illustrate the issues.</p>
<p>Zak Muscovitch</p> <p>"The Trademark ClearingHouse Worked So Well One Company Got 24 new gTLD using The Famous Trademark "The""</p>	<p>See Sunrise Questions Table, Q1(d) through (f).</p> <p>==</p>	<p>George Kirikos: again, I think Zak is referencing charter Preamble questions (d) through (f), and I agree with that analysis. It also might help inform our work on charter Q1(a) [expanding matches when so many</p>

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<p>TheDomains.com, February 1, 2017</p> <p>https://www.thedomains.com/2017/02/01/the-trademark-clearinghouse-worked-so-well-one-company-got-24-new-gtld-using-the-famous-trademark-the/</p> <p>==</p> <p>This article tells how a registrant obtained a trademark for THE, in order to get first dibs on generic domain names such as, the.car, the.career, the.cars, the.casino, the.doctor, and nearly a hundred others.</p>	<p>This article documents instances of how the current system may be used in a manner which was not intended and which may in the view of some registrants, trademark owners, and registries, constitute an abuse of the current system which requires consideration of potential revisions. One must wonder whether it is fair for the current system to enable a sophisticated participant to get first dibs on such common terms through this method, and whether this outcome was what was intended.</p>	<p>dictionary terms have been gamed would allow even more gaming], Q5(b) [potential elimination of mandatory sunrise], Q9 (limiting to the class of goods/services might reduce gaming), and Q10 (“token use” not properly addressed by TMCH validation system). In addition to the article itself, the comments below the article (including one from David Taylor) further illustrate the issues.</p>
<p>Zak Muscovitch</p> <p>"Is The Trademark Clearinghouse Causing New gTLD's To Lose 6X The Number Of Registrations?", TheDomains, March 12, 2015</p> <p>https://www.thedomains.com/2015/03/12/is-the-trademark-clearinghouse-causing-new-gtlds-to-lose-6x-the-number-of-registrations/</p>	<p>See Sunrise Questions Table, Q1(b) and Q1(d) through (f).</p> <p>==</p> <p>This article documents instances of how the current system may be used in a manner which was not intended and which may in the view of some registrants, trademark owners, and registries, constitute an abuse of the current system which requires</p>	<p>George Kirikos: again, I think Zak is referencing charter Preamble questions (b) and (d) through (f), and I agree with that analysis. It also might help inform our work on charter Q1(a) [expanding matches when so many dictionary terms have been gamed would allow even more gaming], Q5(b) [potential elimination of mandatory sunrise], Q9 (limiting to the class of goods/services might reduce gaming), and Q10 (“token use” not properly addressed by TMCH validation system).</p>

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<p>==</p> <p>The article discussed how "as an unintended consequence of trying to protect legitimate trademark holders, there is a lot of game-playing at the TMCH where words like "the" "great", "cool" "luxury" and hundreds of more that are really not what 99.9999% of people would consider trademarked terms like Verizon, Google and Microsoft."</p> <p>The article also claims that "The TMCH said today that 95% of these notices led to the name not being registered, which it said shows the success of the Claims system", but that instead, this may really mean that "it's having the "chilling effect" predicted by opponents of the process, with legitimate registrants being scared away from non-infringing uses of registered marks."</p>	<p>consideration of potential revisions.</p> <p>This article also raises the issue of the effectiveness and intended purpose / unintended consequences of the TMCH.</p>	
<p>Michael Karanicolas</p> <p>How common words like Pizza, Money, and Shopping ended up in the</p>	<p>Sunrise: Preamble: (e) Have abuses of the Sunrise Period been documented by Registrants?</p>	<p>George Kirikos: agree with Michael's analysis. It also might help inform our work on charter Q1(a) [expanding matches when so many dictionary terms have been gamed would</p>

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<p>Trademark Clearinghouse for new TLDs https://domainnamewire.com/2014/02/10/how-common-words-like-pizza-money-and-shopping-ended-up-in-the-trademark-clearinghouse-for-new-tlds/ == The article contains a long list of dictionary words protected in the TMCH, including: active, adventure, auto, balance, bank, best, bet, bicycling, bliss, blues, brand, brand, car, insurance, chef, Christ, Christmas, city, cloud, compassion, craft, credit, credit, direct, dirt, diy, domain, sex, press, finance, fire, flex, flip, gold, gourmet, groove, heart, holiday, hotel, ilove, internet, jazz, karma, kilt, kiss, lifestyle, lux, luxury, Madison, memo, money, natural, ninja, party, philosophy, physics, pizza, power, radio, realestate, rentacar, shopping, skinny, speed, spirit, storage, strategy, style, swing, tango, Texans, texas, ticket, time, travel, vacation, wedding</p>	<p>Sunrise Q9: In light of the evidence gathered above, should the scope of Sunrise Registrations be limited to the categories of goods and services for which the trademark is actually registered and put in the Clearinghouse? == I would call this clear evidence of abuse, as it expands the applicability of trademark protections in the domain name space vastly beyond what might be permitted under any domestic legal framework. Moreover, unlike dictionary words like “mini” or “apple”, which are at least associated with a well-known brand, the inclusion of words like “Christ” and "luxury" seems strongly suggestive that the system is being gamed. == Proposal: Stronger scrutiny over how marks are included and their protections applied, particularly with regard to limiting their application to categories of</p>	<p>allow even more gaming], Q5(b) [potential elimination of mandatory sunrise], and Q10 (“token use” not properly addressed by TMCH validation system). Comments below the article are also helpful in understanding the issues.</p>

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	demonstrated use.	
<p>Michael Karanicolas</p> <p>The numbers are in! Donuts sunrises typically get 100+ domains, but they also got gamed</p> <p>https://domainnamewire.com/2014/01/30/the-numbers-are-in-donuts-sunrises-typically-get-100-domains-but-they-also-got-gamed/</p> <p>==</p> <p>"Donuts had to cough up domains like luxury.guru, cloud.guru, bet.guru, realestate.guru, wedding.clothing, travel.singles, and finance.holdings at sunrise prices of under \$200.</p> <p>All of the claimed trademarks were from Switzerland. And do you know who owns these trademarks and got the above mentioned domains through sunrise? Other new TLD applicants.</p> <p>Specifically, all of them have an address</p>	<p>Sunrise: Preamble: (e) Have abuses of the Sunrise Period been documented by Registrants? 9 In light of the evidence gathered above, should the scope of Sunrise Registrations be limited to the categories of goods and services for which the trademark is actually registered and put in the Clearinghouse?</p> <p>==</p> <p>Evidence of abusive gaming of the sunrise system.</p> <p>==</p> <p>Proposal: Stronger scrutiny over how marks are included and their protections applied, particularly with regard to limiting their application to categories of demonstrated use.</p>	<p>George Kirikos: agree with Michael's analysis. It also might help inform our work on charter Q1(a) [expanding matches when so many dictionary terms have been gamed would allow even more gaming], Q5(b) [potential elimination of mandatory sunrise], and Q10 ("token use" not properly addressed by TMCH validation system). Comments below the article are also helpful in understanding the issues.</p>

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<p>of 427 N. Camden Drive in Beverly Hills. That's the address for .Luxury, What Box? Holdings (another TLD applicant) and lawyer Thomas Brackey. I've also discovered that What Box? has a mark with the TMCH for "credit."</p>		
<p>Michael Karanicolas</p> <p>Digging in on Donuts' Sunrise: Amazon tops the list, gaming, and top registrars</p> <p>https://domainnamewire.com/2014/01/31/donuts-sunrise-data/</p> <p>==</p> <p>".Luxury's backer, What Box? Holdings, and attorney Thomas Brackey, which all share the same mailing address, walked away with 32 domains.</p> <p>What Box was by far the biggest, getting 16 domains including the terms 808, finance, wedding, christmas, realestate, bet, holiday, money, ilove, and travel. Thomas Brackey registered 10 domains with direct and cloud. .Luxury stuck to</p>	<p>Sunrise: Preamble: (e) Have abuses of the Sunrise Period been documented by Registrants?</p> <p>Sunrise Q9: In light of the evidence gathered above, should the scope of Sunrise Registrations be limited to the categories of goods and services for which the trademark is actually registered and put in the Clearinghouse?</p> <p>==</p> <p>Evidence of abusive gaming of the sunrise system.</p> <p>==</p> <p>Proposal: Stronger scrutiny over how marks are included and their protections applied, particularly with regard to</p>	<p>George Kirikos: agree with Michael's analysis. It also might help inform our work on charter Q1(a) [expanding matches when so many dictionary terms have been gamed would allow even more gaming], Q5(b) [potential elimination of mandatory sunrise], and Q10 ("token use" not properly addressed by TMCH validation system). Comments below the article are also helpful in understanding the issues.</p>

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luxury domains with six domains starting with lux and luxury."	limiting their application to categories of demonstrated use.	
<p>Michael Karanicolas</p> <p>.Build Registry Using Questionable Swiss Trademark Registration To Grab "Build" Domains In Sunrise</p> <p>https://onlinedomain.com/2014/02/14/domain-extensions/new-gtlds/build-registry-using-questionable-swiss-trademark-registration-to-grab-build-domains-in-sunrise/</p> <p>==</p> <p>Plan Bee, LLC, the .build registry, is using a valid, but probably based on fake evidence or no evidence at all, trademark from Switzerland to register domain names in the New gTLD sunrise phase.</p> <p>...</p> <p>Here are the sunrise domain name registrations so far: build.construction</p>	<p>Sunrise: Preamble: (e) Have abuses of the Sunrise Period been documented by Registrants?</p> <p>Sunrise Q9: In light of the evidence gathered above, should the scope of Sunrise Registrations be limited to the categories of goods and services for which the trademark is actually registered and put in the Clearinghouse?</p> <p>==</p> <p>Evidence of abusive gaming of the sunrise system.</p> <p>==</p> <p>Proposal: Stronger scrutiny over how marks are included and their protections applied, particularly with regard to limiting their application to categories of demonstrated use.</p>	<p>George Kirikos: agree with Michael's analysis. It also might help inform our work on charter Q1(a) [expanding matches when so many dictionary terms have been gamed would allow even more gaming], Q5(b) [potential elimination of mandatory sunrise], and Q10 ("token use" not properly addressed by TMCH validation system)</p>

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<p>build.contractors build.directory build.equipment build.guru build.kitchen build.land build.lighting build.technology</p> <p>By the way Minardos Group is a construction company and doesn't have to do anything with precious metals. Minardos Construction & Associates owns 2 US construction relater marks named "BUILDING UNIQUE ENVIRONMENTS" and "CREATE BUILD INSPIRE".</p> <p>It is a mystery how a domain name registry from California has a trademark registration for precious metals in Switzerland. Well, actually it is not. They did the registration in Switzerland for a reason. It is obviously very easy to get a trademark for anything there. Their group already had 2 US trademarks so registering a Swiss trademark wouldn't make any sense except if they couldn't</p>		

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<p>get the trademark in the US. They are now using the Swiss trademark for sunrise domain name registrations.</p>		
<p>Michael Karanicolas</p> <p>How Did RetailMeNot Get 849 .Codes Domains In Sunrise Without Any Trademarks?</p> <p>https://onlinedomain.com/2014/08/19/domain-extensions/new-gtlds/how-did-retailmenot-got-849-codes-domains-in-sunrise-without-any-trademarks/</p> <p>==</p> <p>RetailMeNot, Inc. registered 849 .codes domain names in Sunrise without owning any of the corresponding trademarks. The domains were all registered at the 101Domain registrar.</p> <p>The list includes many keyword domains as well as trademark domains of many other companies. How this was done is a mystery to me or maybe not judging from some other activities I have</p>	<p>Sunrise: Preamble: (e) Have abuses of the Sunrise Period been documented by Registrants?</p> <p>Sunrise Q9: In light of the evidence gathered above, should the scope of Sunrise Registrations be limited to the categories of goods and services for which the trademark is actually registered and put in the Clearinghouse?</p> <p>==</p> <p>Evidence of abusive gaming of the sunrise system.</p> <p>==</p> <p>Proposal: Stronger scrutiny over how marks are included and their protections applied, particularly with regard to limiting their application to categories of demonstrated use.</p>	<p>George Kirikos: agree with Michael's analysis. It also might help inform our work on charter Q1(a) [expanding matches when so many dictionary terms have been gamed would allow even more gaming], Q5(b) [potential elimination of mandatory sunrise], and Q10 ("token use" not properly addressed by TMCH validation system)</p>

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<p>discovered with New gTLDs.</p> <p>RetailMeNot may own a couple couple of trademarks such as “RetailMeNot” but it certainly does not own 849 trademarks.</p> <p>RetailMeNot has registered in sunrise period generic domains such as pizza.codes, find.codes, paris.codes, usa.codes, mobile.codes, security.codes, english.codes and hundreds of other.</p> <p>Many of these domains were purchased at premium prices such as sale.codes, live.codes, alaska.codes, hot.codes, college.codes and newyork.codes.</p> <p>The list also includes domains that include trademarks of other companies: mac.codes, nascar.codes and jetblue.codes.</p> <p>...</p> <p>These 849 domains together with the 60 sunrise registrations made by other companies during sunrise period make .codes New gTLD the most successful New gTLD in terms of sunrise domain</p>		

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<p>name registrations. That is highly irregular especially because sunrise domains account for about a 3rd of the total .codes domain registrations.</p> <p>...</p> <p>The .Codes New gTLD entered the Early Access Program (EAP) on the 16th of April 2014 at 16.00 CET. A few hours before that coupon giant RetailMeNot, Inc. registered 849 domain names in sunrise. New gTLD sunrise registrations require that the registrant has a registered trademark and that the trademark is registered with the Trademark Clearinghouse. It is apparent that RetailMeNot, Inc. does NOT have 849 registered trademarks.</p> <p>.Codes has 3,042 domain registrations today so the RetailMeNot, Inc. registrations account for about a 3rd of the .codes total domain registrations.</p> <p>On the same day I found another 25 sunrise registrations that were also registered at 101Domain and are currently behind whois privacy. The list includes domains such as</p>		
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<p>blackfriday.codes and coupons.codes (that is a premium domain):</p> <p>blackfriday2017.codes blackfriday2019.codes blackfriday2016.codes blackfriday2020.codes blackfriday2018.codes blackfriday2015.codes blackfriday2014.codes blackfriday.codes promocode.codes promocodes.codes in-store.codes instore.codes couponcode.codes coupons.codes cybermonday2020.codes disocuntcodes.codes cybermonday2019.codes discountcode.codes cybermonday.codes cybermonday2014.codes cybermonday2015.codes cybermonday2016.codes vouchercodes.codes cybermonday2018.codes cybermonday2017.codes</p>		

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<p>Rebecca L Tushnet</p> <p>Are We Running Out of Trademarks?</p> <p>https://harvardlawreview.org/2018/02/a-re-we-running-out-of-trademarks/</p> <p>==</p> <p>The extent to which common words are already subject to registration in the US</p>	<p>Multiple questions, particularly those having to do with expanding from exact match</p> <p>==</p> <p>It indicates that (1) most common terms are already subject to at least one national registration, (2) new market entrants are having increasing difficulty finding marks, and (3) new market entrants are increasingly incorporating existing words into longer marks, bearing on the wisdom of expanding exact match</p> <p>==</p> <p>Proposal: Stronger scrutiny over how marks are included and their protections applied, particularly with regard to limiting their application to categories of demonstrated use.</p>	<p>George Kirikos: agree with Rebecca's analysis. Helps to inform our work on charter Q1(a) [expanding matches when so many dictionary terms are already potentially in the TMCH database], Q5(b) [potential elimination of mandatory sunrise], and Q9 (limiting to the class of goods/services might reduce concerns).</p>
<p>Kathy Kleiman</p> <p>Transcript of F2F RPM WG Meeting 6 June 2017 Johannesburg</p>	<p>Amadeu's discussion provides data on Sunrise Ques 11 and 12 and probably others as well.</p> <p>==</p>	<p>George Kirikos: agree with Kathy. Amadeu's relevant text is on pages 9-10 of 1st PDF, and pp 33-34 & 37. On p 10, Rubens raises issues related to Charter Question 9. Maxim raises issues related to Q12 on pp 28-30 & 38.. In</p>

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<p>https://schr.ws/hosted_files/icann59johannesburg2017/8a/transcript%20RPM%201%20%2029%20June%202017.pdf%20session%201.pdf</p> <p>https://schr.ws/hosted_files/icann59johannesburg2017/a3/Transcript%20RPMs%20in%20all%20gTLDs%2029%20June%20.pdf%20session%202.pdf</p> <p>==</p> <p>Amadeu Abril i Abril came to our F2F meeting in Johannesburg to share information about his extensive experiences with GEOs. I submit both parts of the transcript of this meeting (note Amadeu is misidentified as "Amadeo Brew" in the 2nd transcript)</p>	<p>Amadeu came to address the WG in our open session to share the problems his registry encountered with Sunrise and GEOs, and to offer some ideas and suggestions.</p>	<p>the 2nd PDF, Maxim mentions expanded matches on p 17-and Amadeu on pp 22-23 (relevant for Charter Question 1). Amadeu on pp 27-31 on ALP, IDN and geoTLD issues (relevant for Q8, Q11, Q12).</p> <p>Maxim Alzoba: I do agree with Kathy. I strongly believe that the additional data provides clarity on ALP, QLP, and non English script issues of TMCH.</p>
<p>Kathy Kleiman</p> <p>WIPO FAQ on Geographical Indications</p> <p>https://www.wipo.int/geo_indications/en/faq_geographicalindications.html</p> <p>==</p>	<p>Sunrise Preamble (a) and (b), Q1, Q5(b), Q8, Q9, Q12;</p> <p>==</p> <p>The scope of the registrations within the TMCH impacts the Sunrise and Claims service broadly and specifically. If the</p>	<p>George Kirikos: I agree with Kathy's analysis.</p>

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Shedding light on what is a GI and what is a trademark.	scope of registrations is different from what the rules intended, that would change the way we evaluate the mechanisms, e.g., Sunrise and Claims, operating off the data in the TMCH.	
<p>Kathy Kleiman</p> <p>Transcription ICANN Copenhagen RPM WG Mtg 11 March 2017 @10:15 CET</p> <p>https://sched.ws/hosted_files/icann58copenhagen2017/81/Transcript%20RPM%20OWG%2011%20March%20Copenhagen.pdf</p> <p>==</p> <p>Discussion with Deloitte re: entry of GI into database & Questions raised by USPTO about marks protected by statute or treaties, including GIs.</p>	<p>Sunrise Preamble, Q1, Q5(b), Q8, Q9 and Q12</p> <p>==</p> <p>Expanding the scope of words entered into the TMCH changes the scope and impact of the systems that use the TMCH, including Sunrise and Claims. These are important considerations for our review.</p>	<p>George Kirikos: I agree with Kathy's analysis.</p>